

Serial No.: 10/511,350

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DEC 22 2006

By this amendment, claims 1, 4 and 5 are revised to place this application in condition for allowance. Currently, claims 1-18 are before the Examiner for consideration on their merits.

Turning now to the prior art rejection, the Examiner maintains the rejection in terms of relying on the Kemp and Crosby prior art references. Claims 1-7 stand rejected under 35 U.S.C. § 102(e) based on Kemp, while claim 1 is rejected under 35 U.S.C. § 102(b) based on Crosby. Claim 2 is now rejected under 35 U.S.C. § 103(a) based on Crosby.

Claims 8-10, 17, and 18 are rejected based on the combination of Crosby and United States Patent No. 5,773,020 to Place et al (Place).

In response to Applicant's last amendment, the Examiner further explained the reasoning for the rejection on page 2 of the Detailed Action. Therein, the Examiner indicated that she can give the claims their broadest reasonable interpretation. In doing so, it is Applicant's understanding that the Examiner has taken the position that claim 1 can be interpreted as presenting two conditions A or B. Condition A only requires that the vasodilator active compound is disposed on the external condom surface in a form, with condition B requiring that the vasodilator active compound is disposed on the external condom surface in a composition that is immiscible with the lubricant. Put another way, the Examiner is interpreting claim 1 to only require the immiscibility limitation to apply to the B condition not both of the A and B conditions. In doing so, the Examiner can then take the position that the prior art that teaches the use of a vasodilator compound in a form reads on claim 1.

While Applicant believes that this is not a proper interpretation of the claim when

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reading the specification and understanding the invention, claim 1 has been revised to make it clear that the immiscibility limitation applies to both the vasodilator active compound when disposed on the external condom surface in a form and when the vasodilator active compound is disposed on the external condom surface in a composition. No new matter is introduced by this amendment, since the specification clearly teaches the scenario now claimed; it is the very invention of Applicant.

As previously argued, the issue in this application is the limitation regarding the immiscibility of the vasodilator active compound and the lubricant. It is respectfully requested that the prior art does not teach this limitation as now recited in claim 1, and the rejections based on 35 U.S.C. § 102 must be withdrawn.

In the rejections based on 35 U.S.C. § 102, the Examiner makes no mention of whether Kemp or Crosby teach the immiscibility aspect of the invention. It is contended that the reason for this silence is that neither of these references teaches what is now defined in claim 1. The previous arguments are also incorporated by reference regarding the failure of the prior art to teach the immiscibility aspect of the invention. The Examiner is called upon to support any further rejection of the claims with citation to page and line number for the support of a contention that the claim limitation in question is either expressly or implicitly disclosed.

Since Kemp and Crosby cannot anticipate claim 1, the only recourse for the Examiner is to reject claim 1 under 35 U.S.C. § 103(a). However, in order to make such a rejection, the Examiner would have to both allege that it would be obvious to make the vasodilator compound used in Kemp and Crosby in a form or in a composition, both of which being immiscible with the lubricant. The Examiner cannot make such an allegation since, absent the teachings of Applicant; there is no reason to make such a change.

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Consequently, any rejection based on 35 U.S.C. § 103(a) could not be sustained on appeal.

In view of the fact that the prior art does not teach each and every limitation of claim 1 and lacks any teaching to support an obvious contention, the Examiner must withdraw the rejection of claim 1. Furthermore, since the remaining dependent claims are all dependent on claim 1, all claims are now in condition for allowance.

Accordingly, the Examiner is respectfully requested to examine this application in light of this Amendment and pass claims 1-18 onto issuance.

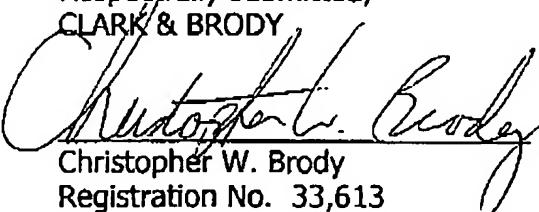
If the Examiner believes that another interview with Applicant's attorney would be helpful in expediting allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated March 13, 2006.

Again, reconsideration and allowance of this application is respectfully requested.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
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Docket No.: 12123-0003
Date: September 5, 2006

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12123-0003

DOCKETED

Non-Compliant Amendment
Response Due: Sept 8, 2007

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,350	10/15/2004	James Bader	12123-0003US	2345
22902	7590	08/08/2006		EXAMINER
CLARK & BRODY 1090 VERNON AVENUE, NW SUITE 250 WASHINGTON, DC 20005				NGUYEN, CAMTU TRAN
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DEC 22 2006

Notice of Non-Compliant Amendment (37 CFR 1.121)	Application No.	Applicant(s)
	10/511,350	BARDER, JAMES
	Examiner	Art Unit
	Camtu T. Nguyen	3743

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

The amendment document filed on 12 May 2006 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- 1. Amendments to the specification:
 - A. Amended paragraph(s) do not include markings.
 - B. New paragraph(s) should not be underlined.
 - C. Other _____.
- 2. Abstract:
 - A. Not presented on a separate sheet. 37 CFR 1.72.
 - B. Other _____.
- 3. Amendments to the drawings:
 - A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - C. Other _____.
- 4. Amendments to the claims:
 - A. A complete listing of all of the claims is not present.
 - B. The listing of claims does not include the text of all pending claims (including withdrawn claims).
 - C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - D. The claims of this amendment paper have not been presented in ascending numerical order.
 - E. Other: See Continuation Sheet.
- 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the entire corrected amendment must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) **only** if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or
Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Continuation Sheet (PTOL-324)

Application No. 10/511,360

Continuation of 4(e) Other: claims 4-7 and 12-16 are improper dependent claims which refers back in the alternative to more than one preceding dependent claim 3.

Henry Bennett
Supervisory Patent Examiner
Group 3700